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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/976,159 11/21/97 BRANDER

N 2656/2

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NEW YORK NY 10004

TM02/1029

EXAMINER

ROMAIN, J

ART UNIT

PAPER NUMBER

2163

DATE MAILED:

10/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/976,159**

Applicant(s)  
**Brander et al.**

Examiner  
**Romain Jeanty**

Art Unit  
**2163**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 20, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12-36 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

Art Unit: 2163

### **DETAILED ACTION**

1. This office action is in response to the amendment files on October 25, 2001 in which Applicant amended claims 1, 9, 14, 21, 28, 29, 31.

#### **Claim Rejections - 35 U.S.C. § 112**

2. Applicant's amendment has overcome the 112 second rejection with regard to claims 9 and 28.

#### **Claim Rejections - 35 U.S.C. § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9, 12-13, 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Depository Trust Company (Herein referred to "DTC") in view of Lupien et al. (US. 5,497,317) as set forth in the prior Office Action of paper number 12.

Art Unit: 2163

5. Claim 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over DTC in view of Lupien (6,098,051) as set forth in the prior Office action of paper number 15

**Response to Arguments.**

a. Applicants asserted that The Depository Trust Company (DTC) neither teaches nor suggests automatically matching received notice of execution information from a broker with institution allocation instruction. In response, the examiner disagrees with the applicants' assertion because nowhere does the original filed claimed invention mention that the matching is being done automatically. Applicant further asserted that The Depository Trust Company (DTC) does not describe matching an institution communication with a broker communication that contains a notice of order execution. The examiner disagrees with applicants' assertion because The Depository Trust Company (DTC) does disclose communicating the trade data via a notification of order execution (i.e., NOE function) (See page 3, lines 1-7 and page 19 line 1 to page 20 line 26). The examiner notes that The Depository Trust Company does disclose communicating trade settlement information which contains notice of order execution (see page 1 line 1 to page 4 line 3). Furthermore, Hawkins discloses a trade settlement system comprising a computer processor to include communication containing trade settlement information (See col. 7, lines 52-66).

b. Applicants asserted that the arguments connection with claims 1-9, 12 and 31-32 and The Depository Trust Company and the Hawkins et al reference apply equally to claim 13. However, it is noted that claim 13 is rejected for the same analysis discussed in regards to claims 1-9, 12 and 31-32 above.

Art Unit: 2163

c. Applicants asserted that The Depository Trust Company (DTC) teaches away from matching of the information in the notice of execution (NOE) and the institution instructions before trade execution. The examiner disagrees with applicants' assertion because it is noted that The Depository Trust (DTC) does disclose matching of information of the order of execution with the institution information (see (See page 3, lines 1-7 and page 19 line 1 to page 20 line 26)).

In response to applicants' assertion of inputting of the trade settlement instructions before trade executions, it would have been obvious to a skilled artisan in the art to input of trade settlement instructions before trade execution. One of ordinary skill in the art would input of trade settlement instructions prior to trade execution in order to ensure that all trade information are correctly entered prior to executing the trade, thereby avoiding future dispute between the two parties after a trade is executed.

d. Applicants asserted that there is no suggestion to combine the Lupien reference and the Depository Trust reference, and The Depository Trust Company reference nor the Lupien et al reference alone or combined, render obvious the subject matter of claims 14-20. However, it is noted that claim 14-20 are rejected for the same analysis discussed in regards to claim 1 above.

In response to applicant's assertion that there is no suggestion to combine the Lupien and The Depository Trust Company, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ

Art Unit: 2163

209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. Both systems are relating to trading system that matches trading information from two parties. Therefore, one having ordinary skill in the trading art would have found it obvious to combine the teachings of these cited references because in order to increase the speed and accuracy of trade settlements.

### **Conclusion**

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached on weekdays from 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached at (703) 305-9643.

Art Unit: 2163

The fax number for Formal or Official faxes to Technology Center 2100 is (703) 746-7239. Draft or Informal faxes for this Art Unit can be submitted to (703) 746-7240.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703)308-3900.

Romain Jeanty

Art Unit 2163

October 25, 2001.

TARIQ R. HAFIZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100